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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/456,270	12/07/99	KOKKO	B 2130 (FJ-99-1)

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IM22/0706

EXAMINER
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ALVO, M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 07/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/456,270

Applicant(s)

KOKKO, BRUCE J.

Examiner

Steve Alvo

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-20 and 31-35 is/are allowed.
- 6) ☒ Claim(s) ✓ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

Art Unit: 1731

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 12-20 and 31-35 are rejected under 35 U.S.C. 103(a) as obvious over OSBORN, III '699 with or without BACK et al '681.

OSBORN, III teaches making an absorbent sheet from a web of fibrous material using a combination of a quaternary ammonium surfactant component and a non-ionic surfactant as debonding agent (column 5, lines 18-24) to produce a sheet having reduced (column 5, line 22) tensile strength. It is well known to recycle newspaper to papermaking processes to provide an economic and environmentally friendly source of wood pulp material. If necessary, BACK et al teaches that absorbent sheets can be made from recycle paper, e.g. newspapers. OSBORN, III teaches that any variety of wood pulp can be used as the

Art Unit: 1731

fibrous material. It would have been obvious to the artisan to use the recycled wood pulp of BACK et al as the wood pulp of OSBORN, III. It would be obvious to the artisan to adjust the amount of debonding materials needed to provide the proper amount of debonding. See OSBORN, III for using alkoxyated and ethoxyated fatty acids and alcohols, including PEG-9 oleate and PEG-4 dilaurate. The specific alkoxyated and ethoxyated fatty acids and alcohols appear to be commercially available. It would have been prima facie obvious to substitute one alkoxyated or ethoxyated fatty acid or alcohol surfactant for another.

Claims 11 and 31-35 are rejected under 35 U.S.C. 103(a) as obvious over OSBORN, III '699 with or without BACK et al '681, for the reasons set forth above in the rejection of claim 1, and further in view of WENDT et al '839. The exact imidazolinium quaternary compound appears to be commercially available. It would have been prima facie obvious to substitute one imidazolinium quaternary surfactant for another.

WENDT et al '839 teaches a process very similar to OSBORN, III to produce a softened absorbent paper using a quaternary compound and a non-ionic surfactant. WENDT et al '839 teaches that using imidazolinium quaternary compounds as the debonding compound has the additional advantage of not adhering to the

*O'Farrel*, 7 USPQ2d 1673, 1680-81. In any event, it is well settled that an artisan with ordinary skill would have found it obvious to determine workable or even optimum values for an art recognized, result effective parameter, such as the proper amount of “debonding”, “absorbency” and “softening”, *In re Boasch*, 205 USPQ 215, 219; *In re Aller*, 105, USPQ 233, 235. OSBORN '699 also teaches (column 4, lines 41-66) the alternativeness of using various alkoxyated esters of a fatty acid as the nonionic surfactant. The use of the elected species, PEG dioleate, would have been obvious from the teachings of OSBORN '699. See OSBORN, III for using alkoxyated and ethoxyated fatty acids and alcohols, including PEG-9 oleate and PEG-4 dilaurate. The specific alkoxyated and ethoxyated fatty acids and alcohols appear to be commercially available. It would have been prima facie obvious to substitute one alkoxyated or ethoxyated fatty acid or alcohol surfactant for another. BACK et al teaches that absorbent sheets can be made from recycle paper, e.g. newspapers. It would have been obvious to the artisan to use the recycled wood pulp of BACK et al as the wood pulp of the ADMITTED PRIOR ART. This would have been especially obvious as the debonding composition (Formulation B) is promoted by its manufacturer as being “Best on virgin and mixed virgin/recycled”, see IDS page 2, last paragraph. Clearly Formulation B can be used on recycled pulp.

WENDT et al '839 cited to show that using imidazolinium quaternary compounds as the debonding compound has the additional advantage of not adhering to the drying surface, which is a problem with other debonder/softening agents.

Applicant has not compared the claimed process to the closest prior art, e.g. formulation A. It would have been prima facie obvious to substitute one nonionic surfactant for another.

Art Unit: 1731

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Any inquiry concerning this communication or earlier communications from the primary examiner should be directed to Steve Alvo whose telephone number is (703) 308-2048. The Examiner can normally be reached on Monday - Friday from 6:00 AM - 2:30 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **(703) 308-0661**.

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Art Unit: 1731

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MSA  
September 9, 2002



**STEVE ALVO**  
**PRIMARY EXAMINER**  
**ART UNIT 1731**